

Appl. No. 10/706,103
Docket No. 9118M2
Amdt. dated December 16, 2008
Reply to Office Action mailed on July 10, 2008
Customer No. 27752

REMARKS

Claim Status

Claims 1-4 and 8-17 are pending in the present application. Claims 5-7 have been previously canceled without prejudice. No additional claims fees are believed to be due.

Claim 14 has been amended to specify the oral conditions treated or prevented by the present invention. Support for the amendment is found in the specification on page 4, lines 21-23. It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, First Paragraph

The Office Action rejects claim 14 under 35 USC §112, first paragraph, for failure to contain a written description of the invention. Specifically, the Office Action states that the use of the term “oral condition” is broad and encompasses a large number of diseases and conditions.

While Applicants do not agree that the rejection is valid, Applicants have amended claim 14 to specify particular oral conditions treated and or prevented by the present invention. Support for the amendment is found in the specification on page 4, lines 21-23, which states, “By ‘oral condition’ as used herein is meant diseases or conditions of the oral cavity including caries, plaque, breath malodor, dental erosion, gingivitis, and periodontal disease.”

Therefore, Applicants respectfully request that the rejection be withdrawn.

Rejection Under 35 USC §103(a) Over Lawlor in view of Fine, et al.

The Office Action rejects claims 1-4, 8-12 and 14 under 35 USC §103(a) as being unpatentable over Lawlor (US 6,706,256) in view of Fine, et al. (US 4,374,822). Claims 13 and 15-17 are rejected under 35 USC § 103(a) as being unpatentable over Lawlor in view of Fine as evident by Grossman et al. J. Dent. Res. 16(5), 409-416, 1937.

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Applicants traverse. Lawlor and Fine do not establish a *prima facie* case of obviousness because there is no motivation to combine them, and even if combined, the references do not teach or suggest all of the claim limitations of the present invention.

Lawlor, as has been discussed in previous responses, does not disclose any of the claimed retentive agents at the levels used in the present invention. As demonstrated in the declaration and data previously submitted and entered into the record (June 12, 2007 response to December 12, 2006 Office Action), the composition of the present invention, when chewed, is deposited and retained in the subject's teeth for at least 5 minutes and up to 60 minutes. In contrast, Lawlor is not visible in a subject's teeth 5 minutes after chewing, much less any time beyond that.

Applicants argue that the citing of the new reference Fine does not render the present invention obvious. While Fine discloses compositions containing broad ranges of water-insoluble polishing agents, it is clear that Fine's focus is its flavoring, and that it never contemplated a composition that would stick and remain visible in a subject's teeth for an extended period of time. Furthermore, there is no motivation, teaching, or suggestion to combine Fine's dental creams with Lawlor, especially because there is no mention in either reference of a result or a desire to have the composition stick and remain visible in a subject's teeth. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability ... the essence of hindsight."¹

Accordingly, Applicants contend that the Office Action fails to establish a *prima facie* case of obviousness and respectfully request that the rejection be withdrawn.

¹ *In re Dembiczak* 175 F. 3d 994, 999 (Fed. Cir. 1999), citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. (BNA) 543, 547 (Fed. Cir. 1985).

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Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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